



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,560	08/28/2003	Eric D. Fox	67519.001037	7600
21967 7590 07/17/2008 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109				
EXAMINER				
BATTULA, PRADEEP CHOUDARY				
ART UNIT		PAPER NUMBER		
3725				
MAIL DATE		DELIVERY MODE		
07/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/650,560

**Applicant(s)**

FOX, ERIC D.

**Examiner**

PRADEEP C. BATTULA

**Art Unit**

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7.9.15.23.31-33 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7.9.15.23.31-33 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**This action is in reply to the response filed on June 9, 2008**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 7, 9 and 15 – 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Honnsbeen.

Honnsbeen discloses in Fig. 1 and 2, a card and a method for securing an item comprising: a cavity (P) in a card portion (C) on a first face (top of the card portion where the second portion item 20a mates) which is within the card portion; the cavity operable to receive an item (15); a second portion (20) connectable to the card portion operable to secure the item (P) in the cavity and to permit the item to be removably inserted from the cavity; a securing mechanism (11a and 20C; both on peripheral edge of cavity and second portion) operable to affix the second portion (20) to the card; wherein the securing mechanism comprises a groove or recessed portion (11a) in the cavity operable to removably secure the second portion (20) to the card (which inherently would inherently comprise one face), an indented portion (20b) relative to top portion (20a) and operable with the card portion to removably connect the card portion to the second portion, and a distal portion (20c) along the edge of the second portion; a magnetic strip (26) on the face of the card and operable to store information of the

issuer of the card, and separate from a projection of the recess onto the face of the card; and wherein the card comprises a transparent face.

Hoonsbeen does not disclose the magnetic stripe operable to enable card transactions, however the only structure provided in such a recitation is the magnetic stripe. If encoded with the proper information the structure of the magnetic stripe could be used to go through a credit card transaction but Hoonsbeen's card is encoded with different formation. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Furthermore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the magnetic stripe of Hoonsbeen with credit card information or other information (such as shown in Page 5, Lines 10 - 14 of the specification) as encoding certain types of finite information is well within the technical field of one having ordinary skill in the art.

In regards to Claim 9, Hoonsbeen further discloses wherein the first face has an at least partially transparent portion to allow viewing of the item in the cavity (Column 1, Lines 59 – 67).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 23, 31 – 33, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoonsbeen and Lam et al. (Lam).

Hoonsbeen discloses in Fig. 1 and 2, an card comprising: a first face and second face parallel to the first face (the examiner considers this to be the interior of the front and back walls of the holder) a recess (P) operable to receive an insert (15) and disposed on one of the first and second faces; a slidable cover (20) operable to secure the item (P) in the cavity and to permit the item to be removably inserted from the cavity; a securing mechanism (11a and 20C) operable to affix the cover (20) to the card; wherein the securing mechanism comprises a groove or recessed portion (11a) in the cavity operable to removable secure the cover (20) to the card, and a distal portion (20c) along the edge of the cover; a magnetic strip (25 and 26) operable to store information of the issuer of the card on the first face, and disposed on the card at a location separate from a projection of the recess onto the first face of the card; and wherein the card comprises a transparent face.

However, Hoonsbeen does not disclose wherein the insert is coupleable to a picture to permit the picture to be removably inserted from a recess and the magnetic stripe enabling card transactions.

With respect to the magnetic stripe enabling card transactions the only structure provided in such a recitation is the magnetic stripe. If encoded with the proper information the structure of the magnetic stripe could be used to go through a credit card transaction but Hoonsbeen's card is encoded with different formation. It has been held that a recitation with respect to the manner in which a claimed apparatus is

intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Furthermore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the magnetic stripe of Hoonsbeen with credit card information or other information (such as shown in Page 5, Lines 10 - 14 of the specification) as encoding certain types of finite information is well within the technical field of one having ordinary skill in the art.

Lam et al discloses in Fig. 4, an insert (56) coupleable to a picture (58) to permit the picture to be removably inserted form a recess (38) from card (20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hoonsbeen's card with an insert having a coupled picture as taught by Lam et al for providing a mounting platform in which to prevent movement of the inserted picture.

In regards to **Claim 23**, the method of the picture being personally selected by the cardholder to customize the card according to one or more particular personal preferences of the cardholder, does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious form a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would have been obvious to customize the cards in any desired manner.

In regards to Claim 41, Hoonsbeen modified by Lam further discloses wherein the one of the first and second faces has an at least partially transparent portion to allow viewing of the item in the cavity (Column 1, Lines 59 – 67; Hoonsbeen).

### ***Response to Arguments***

Applicant's arguments filed June 9, 2008 have been fully considered but they are not persuasive. With respect to the card limitation the Applicant is correct in stating that the slide holder is not a credit card but structurally with respect to the claims it is capable of being used as a credit card considering it does have a magnetic stripe. Also, the magnetic stripe enabling card transactions is not a structural limitation but instead an intended use since the use can be done with any magnetic stripe but only the information needs to be encoded. A credit card's magnetic strip goes through a different encoding process than Hoonsbeen's magnetic stripe but both have the same structure.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3725

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRADEEP C. BATTULA whose telephone number is (571)272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C. B./  
Examiner, Art Unit 3725  
July 9, 2008

/Derris H Banks/  
Supervisory Patent Examiner, Art Unit 3725